

### **REMARKS**

In the Office Action dated July 30, 2009, claims 11, 13-17, 19 and 20 are rejected. Claims 11, 13, 17, 19 and 20 are rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,151,178 to Nickerson et al. (hereafter “Nickerson”) in view of U.S. Patent No. 3,740,019 to Kessell et al (hereafter “Kessell”). Claims 14-16 are rejected under 35 USC §103(a) as being unpatentable over Nickerson in view of Kessell and further in view of U.S. Patent No. 4,635,683 to Neilson (hereafter “Neilson”).

### **References Cannot Be Combined Where Reference Teaches Away from Their Combination.**

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP § 2145.X.D.2.

The Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20 because as clearly stated in the MPEP § 2145.X.D.2., “References Cannot Be Combined Where Reference Teaches Away from Their Combination.” The Office Action admits that Nickerson teaches away from the first guide spring being secured to the plunger distal end as recited in independent Claims 11 and 17. *See Office Action dated July 30, 2009, page 3, lines 1-2.* Therefore, it is improper for the Office Action, as stated in the MPEP, to combine Nickerson with any reference or teachings wherein the combination teaches away from Nickerson’s teachings. Accordingly, the Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20.

### **The Office Action Misapplies *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).**

In addition, the Office Action misapplies the ruling in *Howard* to applicants claimed invention. *See Office Action dated July 30, 2009, page 3, lines 3-5.* In *Howard*, the Court states that it is not an invention “to cast in one piece an article which had formerly been cast in two pieces and put together” (emphasis added). Even if, arguendo, the Examiner considers “a first guide spring being secured to a plunger distal end” as one piece (as recited in Claim 11), Nickerson does not disclose

two pieces (i.e., a guide spring and a plunger) put together. Thus, the Office Action's reliance on *Howard* is in error.

**Mere Statement That the Claimed Invention Is Within the Capabilities of One of Ordinary Skill in the Art Is Not Sufficient By Itself to Establish Prima Facie Obviousness, MPEP § 2143.01.IV.**

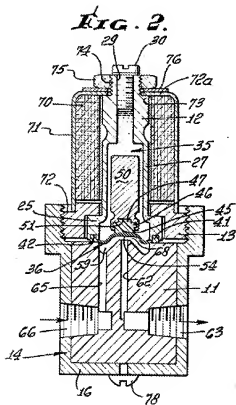
The Office Action statement that “the attachment of two items is obvious to one having ordinary skill in the art at the time of the invention was made” is not sufficient by itself to establish prima facie obviousness. *See Office Action dated July 30, 2009, page 3, lines 2-3*. First, the Office Action ambiguously states that “the attachment of two items is obvious” as opposed to the attachment of “a first guide spring to a plunger distal end” in valve assembly would be obvious. Further, the Office Action provides no support as to why the attachment of “a first guide spring to a plunger distal end” in valve assembly would be obvious to one of ordinary skill in the art at the time of the claimed invention. Therefore, the Office Action fails to provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as required under *KSR*. Accordingly, for at least this additional reason, the Office Action Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20.

**The Office Action Fails to address all Limitations of the Claims.**

The Office Action fails to address Applicants prior claim amendments to Claims 11 and 17. In particular, Claims 11 and 17 recite “wherein the first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position” (emphasis added). The Office Action merely states that Applicants arguments are moot because Kessell exemplifies a parallel mating valve surfaces in both the open and closed positions. *See Office Action dated July 30, 2009, page 2, lines 1-4*. Applicants respectfully disagree that Applicants prior claim amendment is moot. Further, the Office Action fails to indicate how and/or where Kessell discloses “wherein the first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position” as recited in Claims 11 and 17. Therefore, for at least this additional reason, the Office Action Office Action fails to establish a prima facie case of obviousness against 11, 13, 17, 19 and 20.

The Combination of Nickerson and Kessell Does Not Disclose or Even Suggest All  
Limitations of the Claims.

A prima facie case of obviousness against 11, 13, 17, 19 and 20 cannot be established because the combination of Nickerson and Kessell does not disclose or even suggest all limitations of the claims. As previously stated, Kessell does not disclose first and second sealing surfaces “wherein the first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position.” For instance, Kessell’s Figure 2 is depicted below that shows Kessell’s sealing member (i.e., diaphragm 36) as flexible material that can deform to any shape to maintain the volumetric capacity of chamber 35. (See Kessell, col. 4, lines 28-38).



As shown above, diaphragm 36 is flexible and may deform to varying shapes. Therefore, Kessell does not disclose or even suggest that a first sealing surface and the second sealing surface are substantially parallel when said plunger is in said open position as recited in Claims 11 and 17. More particularly, as noted in the detailed description of this application at paragraph [0016], the

angled underside of diaphragm 36 in Kessell is undesirable because of the particle generation caused when such angled underside is deformed, rendering the teachings of Kessell completely opposed to the teachings of the present application. Accordingly, prima facie case of obviousness against 11, 13, 17, 19 and 20 cannot be establish because the combination of Nickerson and Kessell does not disclose or even suggest all limitations of the claims.

In view of the above arguments, Applicants respectfully request the rejection to Claims 11, 13-17, 19 and 20 under 35 USC § 103(a) be withdrawn.

### **CONCLUSION**

Applicants submit that the application is now in condition for allowance, and accordingly, respectfully request the allowance thereof. If, however, the Examiner should for any reason consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Applicants believe no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 19-3140, under Order No. 11000054-0033 from which the undersigned is authorized to draw.

Dated: September 30, 2009

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